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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,635	07/02/2003	Craig W. Ball	P05769US01	4611
22885 7590 05/22/2007 MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			EXAMINER TRAN, KHOI H	
			ART UNIT 3651	PAPER NUMBER
			MAIL DATE 05/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,635

Applicant(s)

BALL ET AL.

Examiner

Khoi H. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

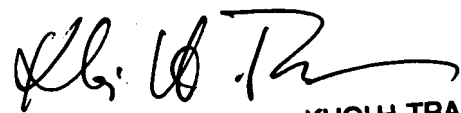
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.


KHOI H. TRAN
PRIMARY EXAMINER

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not provide support for stapling a separately printed label to a printed document without the correlation and merging of the document and shipping label.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Schuricht et al. 5,040,132.

Schuricht et al. '132 disclose a method of printing documents per claimed invention. The method comprises obtaining customer data, obtaining shipping data, and creating variable data forms. The method comprises merging the customer data

and shipping data into the variable data forms. The method comprises printing a supplemental document and a shipping label wherein both the supplemental document and the shipping label are based on the variable data form and both are printed together without the need for frequent correlation and merging.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al. 5,040,132 in view of Harris, Jr. et al. 5,114,128.

Schuricht et al. '132 disclose all elements per claimed method: receiving an intended delivery location with each of a plurality of documents (column 2, lines 55-68); determining a time required to deliver each document to the intended delivery location (column 3, lines 17-21); determining a desired date of receipt (column 9, lines 64-66); determining a time to print each document to allow for the time required to deliver each document on the desired date of receipt (column 10, lines 4-10); obtaining shipping data for each document and printing a label for each document. However, Schuricht '132 is silent as to the specifics of printing the shipping label in-line with printing documents for subsequent mailing.

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Harris et al. '128 disclose method of printing mailing labels in-line or on-line with printing documents to be mailed is known (Figure 1, column 3, lines 46-54, paragraph bridging columns 3 and 4, column 8).

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have generated Schuricht '132 label in-line or on-line with printing documents to be mailed, as taught by Harris et al. '128, because it facilitates known means for generating labels for mailing documents.

It is obvious that after the shipping label has been associated with each mailing document for Schuricht '132 modified method, subsequent correlation and merging of the document and shipping label no longer requires. In addition, Schuricht '132 modified method for printing on-line shipping labels with mailing documents obviously excludes any physical merging steps because it is an on-line, within the same line, printing method.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al. 5,040,132 in view of Harris, Jr. et al. 5,114,128 as applied to claim 1 above, and further in view of Boss 4,770,284.

Schuricht et al. '132 modified method discloses all elements per claimed invention. However, it is silent as to the specifics of stapling a shipping label to the document.

Boss '284 teaches name and address can be applied to mailing documents by ink jet printer, or it can be applied first to a label which is to be pasted, stapled or affixed

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to the mailing documents. Boss '284 shows that stapling shipping label to mailing documents is commonly well known.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have stapled Schuricht et al. '132 shipping label to the mailing documents because it facilitates another commonly well known means of affixing shipping label to mailing documents, as taught by Boss ' 284.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 3, 4, and 12 have been considered but are moot in view of the new ground(s) of rejection.

However, Applicant's arguments filed on 03/27/2007 have not been found to be persuasive. Applicant argued that Schuricht et al. 5,040,132 in view of Harris, Jr. et al. 5,114,128 does not anticipate the claimed invention because it requires subsequent correlation and merging of the document and shipping label. This argument is not persuasive. Per the rejection in paragraph 6 above, once the shipping label has been associated with the mailing document, subsequent correlation and merging of the document and shipping label no longer required. In addition, Schuricht '132 modified method for printing on-line shipping labels with mailing documents obviously excludes any physical merging steps because it is an on-line, within the same line, printing method.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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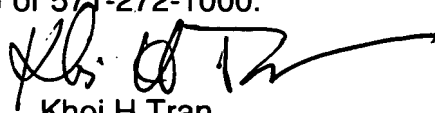
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoi H Tran
Primary Examiner
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KHT
05/16/2007